

## REMARKS

In response to the Office Action mailed on October 3, 2005, Applicants submit the following Amendment and Response. Claim 82 has been amended to correct the dependency of the claim. Therefore, these amendments are made without the addition of new matter. Claims 69, 75, and 83 have been canceled. Claims 53-67, 70-72, 76, 80, and 84-85 remain pending.

### Amendments to the Specification

Please enter the above-specified amendment to the specification, which corrects typographical errors in the relate-back statement. In particular, the serial number for the application that issued as U.S. Patent No. 6,270,464 was incorrectly listed as 09/366,360 instead of 09/336,360. The correct application number is noted in the filing receipt (see Exhibit A). Additionally, the corresponding patents of the issued parent and grandparent applications were added. Therefore, no new matter has been added with this amendment.

### 35 U.S.C. § 112

Claims 69, 75, and 83 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Without conceding the propriety of the rejection, applicants have canceled these claims and respectfully request withdrawal of the rejections.

Claim Objections

Claim 80 was objected to as being dependent from claim 72. As requested, claim 80 has been amended to depend from claim 53. Therefore, applicants respectfully request withdrawal of this objection.

Art Rejections

Claims 53-61, 65-67, 69, 71, 80, 83, and 85 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Cragg et al. (USP 6,071,301). Claim 84 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al., in view of Foerster et al. (USP 6,228,055). Claims 62-64 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al., in view of Amselem et al. (USP 5,576,016). Claim 70 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al., in view of Ersek et al. (USP 5,571,182). Claims 72, 75, and 76 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al., in view of Stinson (USP 6,174,330).

As noted previously by Applicants, these claims were substantially copied from Burbank et al., USP 6,161,034 (the '034 patent) for the purposes of provoking an interference. The '034 patent has a priority date of not earlier than February 2, 1999. Therefore, these rejections over Cragg et al., which has a priority date of not earlier than May 1, 1998, are equally applicable to the '034 patent. The Examiner's refusal to allow Applicants' claims over the Cragg '301 patent is arbitrary and capricious. The Court of Appeals for the D.C. Circuit has repeatedly held that "an agency must treat similar cases in a similar manner unless it can provide a legitimate reason for failing to do so."

*Independent Petroleum Association of America v. Babbitt*, 92 F.3d 1248, 1258 (D.C.Cir.1996)

(citing *National Association of Broadcasters v. FCC*, 740 F.2d 1190, 1201 (D.C.Cir.1984))

“Government is at its most arbitrary when it treats similarly situated people differently.” *Etelson v. Office of Personnel Management*, 684 F.2d 918, 926 (D.C. Cir. 1982). “If an agency treats similarly situated parties differently, its action is arbitrary and capricious in violation of the APA.” *Allergan, Inc. v. Shalala*, 6 Food and Drug Rep. 389, 391, No. 94-1223 (D.D.C. Nov. 10, 1994) (Greene, J.).

In this case, Applicants are “similarly situated” to Burbank et al. in that both Applicants and Burbank et al. have priority dates after the earliest priority date of Cragg et al., the primary art reference at issue. Yet, in contrast to the prosecution of the current application, the Cragg patent was not cited against Burbank et al. and Burbank et al. was allowed and subsequently issued as the ‘034 patent. Due to the arbitrary treatment of the current application, Applicants are prevented from challenging various claims of the ‘034 patent in an interference proceeding. Therefore, Applicants respectfully request withdrawal of the rejections and reconsideration of the claims as amended.

Applicants submit that the claims, as amended, are free of the cited art and are in an appropriate condition for interference with the Burbank ‘034 patent. Please charge Deposit Account No. **50-2862** for any fees required by this submission. If the Examiner has any questions regarding this communication, or feels that an interview might facilitate prosecution of the application, he is invited to contact the undersigned at (949) 760-9600.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: February 3, 2006

By: Diane K. Wong  
Diane K. Wong  
Reg. No. 54,550

JCK/DKW

O'Melveny & Myers LLP  
610 Newport Center Drive, 17<sup>th</sup> Floor  
Newport Beach, CA 92660-6429  
(949) 760-9600



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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/996,878	11/30/2001	3736	523	216226US- 25 CONT	3	37	2

CONFIRMATION NO. 4138

22850  
OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

## FILING RECEIPT



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Date Mailed: 02/01/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Richard E. Fulton III, Grand Junction, CO;  
William R. Dubrul, Redwood City, CA;

## Assignment For Published Patent Application

Artemis Medical, Incorporated, Hayward, CA;

COPY

## Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 09/900,801 07/06/2001  
WHICH IS A CON OF 09/366,360 08/03/1999 PAT 6,260,458  
WHICH CLAIMS BENEFIT OF 60/090,243 06/22/1998  
AND CLAIMS BENEFIT OF 60/092,734 07/14/1998  
AND CLAIMS BENEFIT OF 60/114,863 01/06/1999  
AND CLAIMS BENEFIT OF 60/117,421 01/27/1999

## Foreign Applications

If Required, Foreign Filing License Granted 01/31/2002

Projected Publication Date: 05/16/2002

Non-Publication Request: No

Early Publication Request: No

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FEB 6 2002

Exhibit A

**\*\* SMALL ENTITY \*\*****Title**

Biopsy localization method and device

**Preliminary Class**

600

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Title 37, Code of Federal Regulations, 5.11 & 5.15**

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